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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,698	04/15/2004	Stephen William Byng	7051P003	9170

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EXAMINER	
KIM, ANDREW	

ART UNIT	PAPER NUMBER
3714	

MAIL DATE	DELIVERY MODE
10/28/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/825,698	BYNG, STEPHEN WILLIAM	
	Examiner	Art Unit	
	ANDREW KIM	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 July 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Australia on 4/15/03. It is noted, however, that applicant has not filed a certified copy of the 2003907807 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The method and system claims consist of an abstract idea which is a judicial exception to 35 U.S.C. 101 (i.e., an abstract idea, natural phenomenon, or law of nature) and is not directed to a practical application of such judicial exception (e.g., because the claim does not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result). Specifically, the method needs to be tied to a particular apparatus such as a computer processor and a gaming machine.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3 and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson (US 6,966,834).

Claims 1, 12. Johnson discloses

deriving a value of a jackpot pool (4:36-47);

determining a range of values as a function of the size of the jackpot pool (col. 5 and 6);

using the range of values to generate randomly an outcome in the range of values (5:45-6:46);

determining a range of outcome values of the player that provides a chance of the player winning the jackpot pool , the range of outcome values of the player being dependent on the residual credit used by the player (6:10-19); The credit must be used in order for the player to be considered for the jackpot.

generating the outcome (6:47-7:35);

comparing the generated outcome with the outcome values of the player (6:10-19)

awarding the player with the prize if the generated outcome matches any of the outcome values of the player (6:10-19).

Claims 2, 13. Johnson discloses wherein the prize is the value of the jackpot pool (6:5-47).

Claims 3, 14. Johnson discloses the step of determining an upper limit of the range of values from which an outcome is generated randomly (6:5-47).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4-11 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 6,966,834).

Claims 4, 5, 15, 16. Johnson substantially discloses the invention as claimed but fails to explicitly teach wherein the number of outcome values of the player is equal to the residual credit of the player divided by the denomination of the gaming machine. Instead, Johnson teaches a number range is defined and divided into two separate sections, the winning band and the losing band. However, it would have been obvious to one of ordinary skill in the art to have the number range set based upon the total number of entries or any other number to be compatible with a certain jackpot scheme to cater to the casino operators and increase casino profits. It would have been an obvious design choice because the invention would have substantially worked the same as Johnson's invention. Therefore, one of ordinary skill in the art would have seen the benefit of modifying Johnson with a jackpot win percentage that is determined by the residual credits and denominations to cater to the casino operators and increase casino profits.

Claims 6, 17. Johnson discloses wherein the jackpot pool is defined by an upper limit and comprises contributions of residual credit from a plurality of players, each player in the plurality of players playing on a separate gaming machine, such that the jackpot pool accumulates up to the upper limit of the jackpot pool (6:5-47, 7:24-67).

Claims 7, 18. Johnson discloses wherein the current value of the jackpot pool determines the number of outcome values of the player when the player offers the residual credit of the player to contribute to the upper limit of the jackpot pool (6:5-47, 7:24-67).

Claims 8, 19. Johnson discloses the step of assigning a unique identification code for each player (tables 1-8).

Claims 9, 20. Johnson discloses the step of storing the unique identification code and the outcome values of each player in a storage means (6:41-7:30). The wagers made within the sliding windows are stored for awarding purposes.

Claims 10, 21. Johnson discloses the steps of generating more than one random outcome and comparing each generated outcome to the outcome values of each player (5:5-6:47).

Claim 11. Johnson discloses wherein the range of outcome values of a player is sequential in number (5:5-6:47).

Response to Arguments

Applicant's arguments filed 7/14/08 have been fully considered but they are not persuasive.

The use of the player's residual credits is merely intended use. One of ordinary skill in the art would have found it obvious to apply a jackpot system to residual credits in the same manner as whole credits. In addition, two or more residual credits may result in a whole credit. To obviate this interpretation the Applicant should clarify how many residual credits.

It is inherent that by awarding a game machine, the system also rewards the player that is playing the game. A gaming system would not reward a gaming machine on which a player is not present and playing. In addition, gaming machines should be claimed to comply with 101 requirements.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., This chance is not linked to the turnover of the gaming machine, but is determined entirely in relation to the number of residual credits held by the player) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW KIM whose telephone number is (571)272-1691. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art Unit 3714

10/30/2008 /A. K./
Examiner, Art Unit 3714